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| 09/920,173      | 08/01/2001  | James K. Lacy        | 31660               | 5297             |

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EXAMINER

ARYANPOUR, MITRA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3711

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/920,173

**Applicant(s)**

LACY, JAMES K.

**Examiner**

Mitra Aryanpour

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-82 is/are pending in the application.
- 4a) Of the above claim(s) 74-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 42-73, drawn to a device for a game that substantially mimics an aspect of a sport, classified in class 273, subclass 317.3.
  - II. Claims 74-82, drawn to a method of making a game that substantially mimics an aspect of a sport, classified in class 473, subclass 422.
2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used with the scoring structure positioned in a horizontal position on a playing surface.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification; and because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, and because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Penny Slicer on 16 February 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 42-73.

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Affirmation of this election must be made by applicant in replying to this Office action. Claims 74-82 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

It is noted that if the product claims were subsequently found to be allowable, then any method claims positively reciting the allowable structure would be rejoined and allowed.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 42 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Speers (D279,396).

Regarding claim 42, Speers discloses a game that substantially mimics an aspect of a sport (in the instant case basketball), the game comprising: a scoring structure (the basketball goal) configured and adapted to be removably coupled to an upper portion of a bottle to thereby position the scoring structure for play. The device of Speers can be removably coupled to various support structures including a bottle. However, it should be noted that applicant is not

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claiming a bottle, but merely suggesting that it is capable of being coupled to a support structure such as a bottle.

Regarding claim 43, Speers shows the scoring structure comprises: a backboard (see figures 1 and 5) adapted to be supported in a substantially vertical position when the scoring structure is removably coupled with a bottle or any other support structure; and a basket rim (see figure 3) secured to the backboard and adapted to be supported in a substantially horizontal position (see figure 2) when the scoring structure is removably coupled with a bottle or any other support structure such that a ball may pass through the basket rim. The device of Speers can be removably coupled to various support structures including a bottle. However, it should be noted that applicant is not claiming a bottle, but merely suggesting that it is capable of being coupled to support such as a bottle.

IN ADDITION:

8. Claims 42-46, 52-54, 56-60, 64-66, 72 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Wong (5,752,703).

Regarding claim 42, Wong discloses a game that substantially mimics an aspect of a sport (in the instant case basketball or football) the game comprising: a scoring structure (the combination of the backboard 18 and rim 14) configured and adapted to be coupled to an upper portion of a cup (it should be noted that for purposes of examination a bottle is taken to mean a receptacle having a narrow or wide neck, with or without a handle, and a mouth that can be optionally capped; therefore the cup of Wong is taken to be equivalent to a bottle) to thereby position the scoring structure for play. The scoring structure of Wong as best seen in figures 1 and 3 is attached to a cup. With regards to the scoring structure being removably coupled, the

backboard/ramp (16) is removably attached and the rim (14) it should be noted that for purposes of examination the rim of Wong is taken to be capable of being removably attached to the cup. However, it should be further noted that applicant is not claiming a bottle, but merely suggesting that it is capable of being coupled to a support structure such as a bottle.

Regarding claim 43, Wong shows the scoring structure comprises: a backboard (16) adapted to be supported in a substantially vertical position when the scoring structure is removably coupled with a bottle or any other support structure; and a basket rim (14) secured to the backboard and adapted to be supported in a substantially horizontal position (see figure 1) when the scoring structure is removably coupled with a bottle or any other support structure such that a ball (46) may pass through the basket rim (14).

Regarding claim 44, Wong shows the game additionally comprises a shot ramp (see column 1, lines 45-52; also column 3, lines 41-44) adapted to launch a ball (46) toward the scoring structure (see figures 1 and 3).

Regarding claim 45, Wong shows the ramp to be a board (16), but is silent with regards to the use of a coaster to form a ramp. For purposes of examination a coaster is taken to mean a disk, plate, or small mat placed under a bottle, pitcher, or drinking glass to protect a tabletop or other surface beneath. In the instant case, Wong's board (16) when not used as a target game, can be utilized as a coaster.

Regarding claim 46, Wong shows the game additionally comprises a retaining clip (20 in figure 1 and 36 in figure 3; best seen in figure 5) configured to removably couple the scoring structure to an open bottle. For purposes of examination a clip is taken to mean any of various

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devices for gripping or holding things together. In the instant case the tab is considered to be a functional equivalent to a retaining clip.

Regarding claim 52, Wong shows the scoring structure is a football goal comprising a cross bar, a left upright and a right upright (see figure 1; also column 3, lines 28-35).

Regarding claim 53, Wong shows the football goal additionally comprises a goal post, which is part of the game board and it is adapted to be removably coupled to the support cup (see figure 1). With regards to the support being a bottle see the comments for claim 1.

Regarding claim 54, Wong shows the game additionally comprises a kicking tee (50) adapted to support a ball (46) in a kicking position for launching a ball (46) toward the scoring structure.

Regarding claim 56, see the comments for claim 42.

Regarding claim 57, see the comments for claim 43.

Regarding claim 58, see the comments for claim 44.

Regarding claim 59, see the comments for claim 45.

Regarding claim 60, see the comments for claim 46.

Regarding claim 64, see the comments for claim 52.

Regarding claim 65, see the comments for claim 53.

Regarding claim 66, see the comments for claim 54.

Regarding claim 68, see the comments for claims 42 and 43

Regarding claim 72, see the comments for claims 1 and 52.

Regarding claim 73, see the comments for claim 53.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (5,752,703).

Regarding claim 47, Wong is silent with regards to the support structure, in the instant case the soda pop cup having a lid. As it is well known the lid is an optional feature that comes with cups such as the one described by Wong and to include a lid would be an optional matter of choice. In the instant case it would also allow the game device of Wong to be used as a rebounding surface. With regards to the retaining clips see the comment for claim 46.

11. Claims 55, 67, 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (5,752,703) in view of Davey, III (6,116,605).

Regarding claim 55, Wong provides a target game for placement on a tabletop. Wong is silent with regards to the target game being held in a raised position. Various means are well known in the game art for aiding attachment of a game apparatus to a support surface e.g. clips, suction cups, screws, nuts & bolts or magnets. Davey, III shows such an attachment. Davey, III shows a magnetic sports-toss game, wherein the target frame (34) is magnetically attached to a surface (1). In view of Davey, III, it would have been obvious to one having ordinary skill in the



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art to have included an attachment means within the Wong reference, the motivation being so that the target game can also be utilized in an area, other than just the tabletop.

Regarding claim 67, see the comments for claim 55.

IN ADDITION:

12. Claims 42, 44, 48, 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Carver et al (3,074,720).

Regarding claim 42, Carver et al discloses a game that substantially mimics an aspect of a sport (in the instant case basketball), the game comprising: a scoring structure (18) configured and adapted to be removably coupled to an upper portion of a support structure (14) to thereby position the scoring structure for play. It should be noted that applicant is not claiming a bottle, but merely suggesting that it is capable of being coupled to a support structure such as a bottle.

Regarding claim 44, Carver et al shows the game additionally comprises a shot ramp (platform 30) adapted to launch a ball (46) toward the scoring structure (see figures 1 and 3).

Regarding claim 48, Carver et al shows the game additionally comprises a ball deflector (106) adapted to be removably coupled with a lower portion of support structure (14) and configured to deflect any ball (20) that may pass through the basket rim (see figures 7 and 8).

Regarding claim 50, Carver et al shows the game further comprises a circular shot ring (best seen in figure 9 the bold circular marking on the support base 12 defining the ball launching area) adapted to define an area wherein a ball (20) must appear (the ball is held in place prior to being triggered or released towards the basket) prior to entering the basket rim (18).

Regarding claim 51, Carver et al shows the game additionally comprises a tubular net (the simulated basket 18) depending from the basket rim (see figure 1). For purposes of examination a tubular net is taken to mean a tubular goal, and in the instant case the simulated basket of Carver et al is considered by the examiner to be equivalent to the claimed tubular net and rim.

IN ADDITION:

13. Claims 56, 57, 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (2,889,149) in view of Stein (2,939,236).

Regarding claims 56 and 57, Williams discloses a game that substantially mimics an aspect of the sport of basketball comprising: a backboard (47) providing a surface for deflecting a ball; a coupling member (23, 26) configured to couple the backboard to an upper portion of a support structure (11) in a substantially vertical orientation; and a basket rim coupled with the backboard (47) configured to accommodate a ball passing therethrough. Williams is silent with regards to the game device being supported on a structure in the shape of a bottle. Stein shows a support structure (15) for displaying an advertising sign (20), wherein the support structure comprises a bottle (see figure 1). In view of Stein, it would have been obvious to one having ordinary skill in the art to have used a bottle-shaped support for securing the game device of Williams, the motivation being so that the target game can also be utilized with existing support structures so that it would be more cost effective.

Regarding claims 61 and 62, Williams shows a ball deflector (48), but is silent with regards to the use of a coaster to form a ball deflector. For purposes of examination a coaster is taken to mean a disk, plate, or small mat placed under a bottle, pitcher, or drinking glass to

protect a tabletop or other surface beneath. In the instant case, Williams's deflector is capable of being used as a coaster.

Regarding claim 63, Williams is silent with regards to providing a circular shot ring adapted to define an area wherein a ball must appear prior to entering the basket rim. However, this is an inherent feature that has been adapted when engaging in a game of basketball, and it would have been obvious to include a circular shot ring for the target game of Williams, the motivation being to demarcate a designated starting point.

IN ADDITION:

14. Claims 68 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (2,889,149).

Regarding claim 68, Williams discloses a game that substantially mimics an aspect of the sport of basketball comprising: a backboard (47) providing a surface for deflecting a ball; a coupling member (23, 26) configured to couple the backboard to an upper portion of a support structure in a substantially vertical orientation; and a basket rim coupled with the backboard configured to accommodate a ball passing therethrough. The device of Williams can be removably coupled to various support structures including a support that is in the shape of a bottle. However, it should be noted that applicant is not claiming a bottle, but merely suggesting that it is capable of being coupled to a support structure such as a bottle.

Regarding claim 69, Williams shows a ball deflector (48), but is silent with regards to the use of a coaster to form a ball deflector. For purposes of examination a coaster is taken to mean a disk, plate, or small mat placed under a bottle, pitcher, or drinking glass to protect a

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tabletop or other surface beneath. In the instant case, Williams's deflector is capable of being used as a coaster.

***Conclusion***


15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carter; Hoofer; Matton; Bliss; Poynter; Collins, Jr.; Adler; Ghovanloo; Hailey; Morano, Jr.; Helalian; Montgomery; Thomas; Weng et al; Kaufmann.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA  
23 February 2004

  
**MITRA ARYANPOUR**  
**PATENT EXAMINER**